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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,724	03/10/2000	Lone Wolinsky	247/212	5199

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LYON & LYON LLP  
633 WEST FIFTH STREET  
SUITE 4700  
LOS ANGELES, CA 90071

EXAMINER

BUI, VY Q

ART UNIT PAPER NUMBER

3731

DATE MAILED: 06/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/522,724

Applicant(s)

WOLINSKY ET AL.

Examiner

Vy Q. Bui

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 and 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 7-10 and 12-15 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of the restriction between Group I and Group II and cancellation of claims 16-20 in Paper No. 6 is acknowledged.

Applicant's election with traverse of the restriction of species I and species II in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the species in Fig. 1 (sensor 12 is placed within the support of stent 16, see page 13, lines 8-19, the specification of the present invention) and Fig. 2 (sensor 12 is placed on the outer surface 18 of graft 14, see page 11, lines 14-15, the specification of the present invention) are not separate species. The applicants also request that species I (Fig. 1) and species II (Fig. 2) are joined into one species.

This traversal and request to consider species shown in Fig. 1 and species shown in Fig. 2 as one species is considered as an admission that the arrangement in Fig. 2 is an obvious arrangement of Fig. 1. This admission is acknowledged and accepted by the examiner.

Claims 1-6 and 11 are considered as related to species I (Fig. 1 and Fig. 2) and are now examined on the merit.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 4-6, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by CIMOCHOWSKI et al (5,967,986).

As to claims 1, 4-6, and 11, CIMOCHOWSKI (Fig. 19-22) discloses an endoluminal implant (including stents or stent-grafts, see abstract, lines 9-13; column 4, lines 21-22) with biosensor 220 (Figs. 19-21A) directly attached to stent 222 by adhesive 228 (column 22, lines 53-56). Biosensor can be a fluid flow sensor or other sensors to sense other physical or biological parameters (abstract, lines 13-22). CIMOCHOWSKI also discloses that the endoluminal implant can be a self-expanding stent-graft (column 25, lines 41-54) and also can be assisted by balloon (column 25, lines 54-58). Notice that self-expanding stents/stent-grafts and balloon-expanding stents/stent-grafts are well-known endoluminal implants.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 2-3 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over CIMOCHOWSKI et al (5,967,986).

As to claims 2-3, CIMOCHOWSKI discloses sensor 220 attached to an outer surface of stent 222 by adhesive 228 (Fig. 19; column 22, lines 53-56). As defined by

Art Unit: 3731

the reference, an endoluminal implant includes a stent/stent-graft (abstract, lines 9-13; column 4, lines 21-22). CIMOCHOWSKI (Fig. 19) shows explicitly stent 222 as an endoluminal implant. However, according to the reference, the invention in the reference also includes stent-graft and it appears that there is no difference between attaching a sensor to a stent or a stent-graft. Therefore, it is reasonable to conclude that CIMOCHOWSKI inherently discloses attaching a sensor to an outer surface of a stent (shown in Fig. 19) or to an outer a stent-graft (not shown). Alternatively, according to CIMOCHOWSKI disclosure, it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach a sensor to an outer surface of a stent-graft so that one biological parameter can be measured.

### ***Conclusion***

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Pat. 5,040,538 discloses an oxygen sensor 26 place inside a heart and US Pat. 5,662,711 discloses an oxygen sensor 114 placed in a shunt 100.


2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 703-306-3420. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2708 for regular communications and 703-308-2708 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

VQB 

6/14/2002.

  
MICHAEL J. MILANO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700